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09/337,802	06/22/1999	ROBERT W. LUFFEL	109800296-1	9485

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EXAMINER

DAVIS, DAVID DONALD

ART UNIT PAPER NUMBER

2652

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 09/337,802

Filing Date: June 22, 1999

Appellant(s): LUFFEL ET AL.

Bruce E. Dahl
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 8, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims s 1, 3-7, 12-19 and 24 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 3-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/371,708. Both sets of claims recite a translation apparatus for a translation device including a first elongate gear rack; a second elongated gear rack; a first drive pinion and a second drive pinion and a drive pinion apparatus.

This is a provisional obviousness-type double patenting rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 3-7, 12-19 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Tadokoro et al (US 6,166,877). Figure 19 of Tadokoro et al shows a modular data storage system for handling and storing data cartridges. Figure 19 also shows at least two laterally adjacent modular units; with each unit including a plurality of cartridge access devices 2. Figure 20 shows first and second elongated gear racks 32 aligned along a displacement path and positioned space-apart. Figure 19 of Tadokoro et al shows devices 2, which include racks 32, substantially in alignment with one another.

Figures 20 and 21 show first and second drive pinions 41 mounted to cartridge access device 2 engaging respective racks 32. Pinion drive motor 34, as shown in figure 20 of Tadokoro et al, is operatively associated with pinions 41. Motor 34 rotates pinions 41 to move cartridge access device 2 among racks 32.

Figures 21 and 22 of Tadokoro et al show rack 32 including first and second elongated guide members 8 that extend along the displacement path substantially between first and second ends of racks 32. Bearings 33 mounted to cartridge device 2 engage first and second guide member 8. Also shown in figures 21 and 22 is first and second guide members 8 including first and second opposed bearing surfaces with bearings 33, which are mounted to device 2, slidably engaging the opposed bearing surfaces of member 8. Figures 20 of Tadokoro et al further shows motor 34 with worm and worm gear 39 attached to the shaft of motor 34 such that gear 39 is operatively connected to pinions 41.

(11) Response to Argument

In the first paragraph on page 20 appellants assert “Tadokoro’s two-piece guide member and gear rack arrangement teaches away from the **one-piece**, integral arrangement of the present invention.” Emphasis added.

Appellants arguments are not germane to the **claimed invention**. Appellants have not claimed a “one-piece” guide member and gear rack arrangement. Appellants claim an “integral” guide member and gear rack. The words are not synonymous. It is well established that integral is defined to mean rigidly secured, fastened or welded. Integrally is not necessarily restricted to a one-piece article. [*In re Clark*, 102 USPQ 241 (CCPA); *In re Hotte*, 177 USPQ 326 (CCPA);

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In re Kohno, 157 USPQ 275 (CCPA); *In re Dike*, 157 USPQ 581 (CCPA); *In re Larson*, 144 USPQ 347 (CCPA 1965).] Also, *Webster's II: New Riverside University Dictionary* defines integral as "Essential for completeness" or "A complete unite: WHOLE". Neither the courts nor the dictionary define or suggestion the word "integral" to mean "one-piece", as purported by appellants.

In the first full paragraph on page 22, appellants contend "Tadokoro's vertical guide member is guided along the guide member 8 by wheels, not by slidable engagement." *Webster's II: New Riverside University Dictionary* defines "slide" as "To move over a surface while maintaining smooth, continuous contact". Wheels 33 move over guide 8 while maintaining smooth, continuous contact.

In the second full paragraph on page 23, appellants maintain, "Tadokoro's gear rack 32 does not provide a guidance function nor does Tadokoro disclose a bearing that contacts his gear rack." First of all the claims do not require guidance. Assuming arguendo, the claims did a gear rack does provide guidance because the gear (bearing or wheel) travels (or is guided) along the rack in the direction of the rack. Secondly, a gear is a bearing, contrary to appellants' assertion. *Webster's II: New Riverside University Dictionary* defines "bearing" as "a device that supports, guides, and reduces the friction of motion between fixed and moving machine parts." And the gear, bearing or wheel of Tadokoro does all of those things.

In the first paragraph on page 24, appellants assert that ~~since the~~ worm and worm gear are not **directly** attached to motor 34, "Tadokoro cannot anticipate claim 12." It should be noted that appellants did not claim require direct attachment of the worm and worm gear.

The arguments on pages 24-27 have already been addressed in the paragraphs supra.

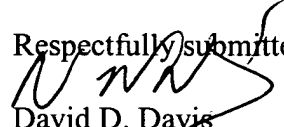
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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


David D. Davis
Primary Examiner
Art Unit 2652

ddd

October 17, 2002

Conferees

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